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Supreme Court, U. S.

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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,

Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
AND ALTHON ENTERPRISES, INC.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF LITTON SYSTEMS, INC.,
AS AMICUS CURIAE
IN SUPPORT OF PETITIONERS**

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INTEREST OF AMICUS CURIAE

With the consent of the parties,¹ *amicus curiae* Litton Systems, Inc. ("Litton"), hereby submits this brief in support of petitioners Herbert Markman and Positek, Inc. Although Litton has no direct interest in the outcome of the case at bar, it has a strong and abiding interest in the question presented concerning the constitutionally guaranteed role of the jury in patent disputes. As a technology-based company whose business depends heavily on innovation and intellectual property, Litton is sometimes involved in litigation to protect the valuable patents it holds.² In such litigation, Litton is entitled to the jury-trial rights granted by the Constitution.

INTRODUCTION AND SUMMARY OF ARGUMENT

In this Seventh Amendment case, the United States Court of Appeals for the Federal Circuit has held that "the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of *law* exclusively for the court," Pet. App. 5a (emphasis added),³ regardless of whether the definition of a disputed claim term can be found in the patent or its prosecution history and regardless of whether the definition turns on extrinsic technical or scientific evidence. The decision below is inconsistent with both clauses of the Seventh Amendment.

I. Interpreting a patent claim is a quintessentially *factual* inquiry into "what one of ordinary skill in the art at the time of the invention would have understood the term to mean." 48a. Patent claims are written from the perspective of those "skilled in the art." 35 U.S.C. § 112. "The specification of the patent is not addressed to lawyers" *Carnegie Steel v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902). The Federal Circuit itself acknowledged even in the decision

¹ Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of the Court.

² See, e.g., *Litton Systems, Inc. v. Honeywell, Inc.*, Nos. 95-1242, 95-1311 (Fed. Cir.) (pending); *Litton Systems, Inc. v. Sunstrand Corp.*, 750 F.2d 952 (Fed. Cir. 1984); *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).

³ Citations to the Appendix to the Petition for Certiorari are styled "___a."

under review that interpreting a patent often requires weighing conflicting "expert and inventor testimony" bearing both on "'how those skilled in the art would interpret the claims,'" 31a (citation omitted), 33a, and on "the state of the prior art at the time of the invention." 33a. The Court of Appeals explained that it was "using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language." 36a. The Federal Circuit has frequently observed that interpreting a patent's scope requires a factfinder to "give consideration and weight to several underlying factual questions, including . . . the description of the claimed element in the specification, the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses." *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.*, 945 F.2d 1546, 1550 (Fed. Cir. 1991); see also *Silsby v. Foote*, 55 U.S. (14 How.) 218, 226 (1852) ("How could the judge know this as a matter of law? . . . [I]t therefore became a question for the jury, upon the evidence of experts.").

In the decision below, however, the Federal Circuit overruled a decade of its own precedent and transformed disputed issues of fact into judicially resolvable issues of "law." The Court of Appeals reasoned that, however disputed they may be, factual issues subsumed or mixed in an overall legal question may be withdrawn from the jury and decided by the court or, if decided by the jury, may be freely re-examined by a reviewing court. But the central lesson of *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 470 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 511 (1959), is that an otherwise applicable right to jury trial cannot be lost simply because issues for the jury are intertwined with issues for the court. See also *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1872) ("though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may, on this mixed question of law and fact, lay down to the jury which should govern them, . . . the ultimate response to the question must come from the jury").

The Federal Circuit's decision also ignores the second portion of the Seventh Amendment, the Re-Examination Clause, which provides that "no fact tried by jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law." See *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.). In this case, the question of infringement was submitted to the jury, which found that respondents had infringed two of the three claims at issue. 13a. The jury was instructed to interpret the patent, and did so, as part of its decision. 16a. But the Federal Circuit held that the jury's verdict amounted to an advisory ruling on "a matter of law," to be re-examined freely by a district court and "reviewed *de novo* on appeal." 30a.

The Federal Circuit's remarkable decision would withdraw from the jury, even *after* it had rendered its verdict, the power to resolve disputes over how one "skilled in the art" would understand a disputed technical term. The Federal Circuit has claimed for itself the authority to decide this question *de novo*, even though it has no first-hand opportunity to evaluate credibility, weigh evidence, or perform any other of the usual tasks essential to factfinding.⁴

In the eighteenth century, arbitrary review by English courts — including the assertion of appellate power by the Privy Council in Westminster — was a principal grievance of the American colonists. Accordingly, the Seventh Amendment reflects a deliberate decision to restrict judicial power and particularly to limit "appellate jurisdiction over matters of fact." Hon. Patrick Higginbotham, *Continuing the Dialogue: Civil Juries and the Allocation of Judicial Power*, 56 TEX. L. REV. 47, 50 (1977). *De novo* review by a distant Federal Circuit is no more appropriate than was review by a distant Privy Council in colonial times.

⁴ "To suggest that appellate judges, precious few of whom are trained in science, will always arrive at the 'true' meaning of words embodying complex concepts endows them with knowledge and enlightenment far beyond those who have training and experience in the field. They are in no position to declare the state of knowledge in the art or that scientific hypotheses are correct as a matter of law." *Pall Corp. v. Micron Separations, Inc.*, Nos. 91-1393, *et al.*, 1995 U.S. App. LEXIS 27366, *39 (Fed. Cir. Sept. 26, 1995) (Mayer, J., concurring in judgment).

If permitted to stand, the decision below would establish a dangerous principle that could not logically be confined to the context of patent claim interpretation or even to patent law. The Federal Circuit's error goes to the fundamental distinction between law and fact and the role of that distinction in the operation of the Seventh Amendment generally. Under the decision below, federal courts may — indeed, *must* — displace juries and arrogate to themselves the power to resolve factual issues whenever those issues are mixed with or immersed in a legal question such as claim interpretation. Until now, it has always been thought that the ultimately legal nature of questions like "negligence" in a tort case, the "reasonableness" of a restraint of trade in an antitrust case, or the "breach" in a contract case does not authorize a judge to strip a jury of the power to decide subsidiary issues of disputed fact. Yet the Federal Circuit's reasoning would justify just such an unconstitutional invasion of the jury's domain.

II. The Federal Circuit maintained that the interpretation of a patent is analogous to the construction of a statute and therefore a matter of law exclusively for the court. But this Court has held that patents are properly analogous to contracts or deeds, not to statutes. See *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (contract); *Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) (deed). In any event, how a particular term was understood in the relevant community at a given point in time is *precisely* the kind of adjudicative fact that, when legally relevant, is routinely submitted to a jury for resolution *even in the statutory context*. For example, this Court recently held, unanimously, that a jury is required to determine whether a given statement was "material" within the meaning of the federal securities laws, on the ground that this is "a 'mixed question of law and fact' [that] has typically been resolved by juries." *United States v. Gaudin*, 115 S. Ct. 2310, 2314 (1995). This Court has also held that "the underlying inquiry whether a vessel is or is not 'in navigation' for Jones Act purposes is a fact-intensive question that is normally for the jury and not the court to decide." *Chandris, Inc. v. Latsis*, 115 S. Ct. 2172, 2192 (1995).

Nor can the decision below be justified as promoting predictability in claim interpretation. District court judges are free

to disagree with one another, as are different panels of the Federal Circuit. In any event, "the concerns for the institution of jury trial that led to . . . the Seventh Amendment were not animated by a belief that use of juries would lead to more efficient judicial administration." *Parkland Hosiery Co. v. Shore*, 439 U.S. 322, 343 (1979) (Rehnquist, now C.J., dissenting). As former Chief Judge Markey has observed:

However some may view what they see as a "better system," . . . judges are nowhere authorized to exercise their personal predilection by revising or repealing the Seventh Amendment. The arguments supporting denial of a jury demand in complex civil cases are clearly submissible to the Congress or to the States in support of a proposal under Article V of the Constitution; they are not appropriately submissible to judges sworn to uphold that Constitution. . . .

SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1128-29 (Fed. Cir. 1985) (*en banc*) (separate opinion).

To be sure, when the evidence regarding the proper interpretation and construction of a patent claim does not give rise to a *genuine* factual dispute, the judge may rule on the construction of the claim as a matter of law. Summary judgment is available in patent cases as in any other. *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). But when there are disputed factual questions bearing on a federal suit seeking damages for patent infringement, a jury must be called upon to resolve those factual questions — just as in other areas of the law where the underlying right to jury trial is not in doubt.

The judgment of the Court of Appeals should be vacated and the case remanded to permit the Federal Circuit to decide in the first instance whether there is a genuine factual dispute over the meaning of the particular patent claim at issue in this case.⁵

⁵ This Court could not, without undertaking an independent review of the record in this case, affirm the judgment on the alternative ground that there was no genuine factual dispute about the meaning of the term "inventory." Although one judge, writing separately, relied on such reasoning in concurring in the judgment below, see 81a-82a (Rader, J., concurring), the opinion for the court expressly rejected such an approach. See 55a. Accordingly, there was no majority in the Federal Circuit for the proposition that — were the Court of Appeals wrong about the constitutional

ARGUMENT

The pivotal importance of the Seventh Amendment in our constitutional scheme is illustrated by its central role in stimulating the creation of the entire Bill of Rights.⁶ The jury is, in the words of legal historian and Judge Morris Arnold, "the single most important institution in the history of Anglo-American law."⁷ Accordingly, "[m]aintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with utmost care." *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935).

The Federal Circuit's decision cannot survive such scrutiny. Judge Newman observed that "[t]his holding not only raises a constitutional issue of grave consequence, but the court creates a litigation system that is unique to patent cases, unworkable, and ultimately unjust." 84a (dissenting opinion). She filed a lengthy opinion exhaustively documenting the logical, historical, and constitutional flaws in the Federal Circuit's decision. See 84a-158a. Judge Mayer, writing separately, predicted that the decision would lead to "turbulence and cynicism in patent litigation." 57a (opinion concurring in the judgment). He maintained that the holding "jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment" and "marks a sea change in the course of patent law

question — the district court's judgment could be affirmed on the alternate ground suggested by Judge Rader.

⁶ See, e.g., Charles Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639, 657 (1973) ("the entire issue of a Bill of Rights was precipitated at the Philadelphia Convention by an objection that the document under consideration lacked a specific guarantee of jury trial in civil cases"); see generally *Edmonson v. Leesville Concrete Co.*, 500 U.S. 614, 624 (1991); *Parkland Hosiery Co. v. Shore*, 439 U.S. 322, 338-44 (1979) (Rehnquist, now C.J., dissenting); *United States v. Wonson*, 28 F. Cas. 745, 750 (1812) (Story, Circuit Justice); Justice Clark, *The American Jury: A Justification*, 1 VALPARAISO L. REV. 1, 1-7 (1966).

⁷ *The Civil Jury in Historical Perspective*, in THE AMERICAN CIVIL JURY 9-10 (1987).

that is nothing short of bizarre." *Id.* Judge Mayer warned that "today's action is of a piece with a broader bid afoot to essentially banish juries from patent cases altogether." 58a.⁸

If permitted to stand, the decision below would establish a principle threatening the settled role of the jury in resolving factual disputes throughout patent law and in many (and perhaps most) other kinds of federal civil litigation.

I. THE DECISION BELOW INVADES THE JURY'S CONSTITUTIONAL ROLE BY ERASING THE DISTINCTION BETWEEN LAW AND FACT

1. Patents are addressed to those skilled in the art, not to those in the legal community. A patent's construction depends on "how one of ordinary skill in the relevant art at the time of the invention would comprehend the disputed word or phrase in view of the patent claims, specification, and prosecution history."⁹ Patent claims must distinctly describe the invention to those skilled in the art, not to lawyers. 35 U.S.C. § 112. Claims must be non-obvious to those

⁸ This note of caution was not without basis. Judge Nies, a member of the *Markman* majority, had previously argued that "[a] constitutional jury right to determine validity of a patent does not attach to this public grant. Congress could place the issue of validity entirely in the hands of an Article I trial court with particular expertise if it chose to do so." *In re Lockwood*, 50 F.3d 966, 983 (Fed. Cir. 1995) (opinion dissenting from order denying rehearing in banc), cert. granted, 115 S. Ct. 2274 (1995), vacated and remanded, 64 U.S.L.W. 3182 (U.S. Sept. 1, 1995).

Similarly, in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (*en banc*) (*per curiam*), a substantial minority of the Federal Circuit, each of whom was in the majority in *Markman*, argued that the factual issue of infringement under the doctrine of equivalents (see p. 18, n.27, *infra*) was for the court, not the jury, to decide. Circuit Judge Plager, joined by Chief Judge Archer and Circuit Judges Rich and Lourie, maintained that, "[i]f we go wrong" in withdrawing the matter from the jury, "the Supreme Court, sooner or later, will correct us." *Id.* at 1545 (dissenting opinion).

⁹ *Pall Corp. v. Micron Separations, Inc.*, Nos. 91-1393, et al., 1995 U.S. App. LEXIS 27366, *35-36 (Fed. Cir. Sept. 26, 1995) (Mayer, J., concurring in judgment).

skilled in the art, not to lawyers. *Id.* at § 103. Patents must be sufficiently detailed to enable one skilled in the art — not a lawyer — to practice the invention. *Carnegie Steel*, 185 U.S. at 437.

As the Federal Circuit itself noted in the decision below, "[a] judge is not usually a person conversant in the particular technical art involved and is not the hypothetical person skilled in the art to whom a patent is addressed." 50a. Thus, while patent examiners are technically proficient, they are not required to have a law degree. 35 U.S.C. §§ 3-7; 37 C.F.R. §§ 1.101-1.110. Similarly, patent agents without law degrees (but with technical degrees) are licensed by the U.S. Patent and Trademark Office to prosecute patents. 37 C.F.R. § 10.6(b).

What meaning a person skilled in the relevant art would assign to a particular patent term is necessarily a question of empirical fact, verifiable or falsifiable by the weighing of evidence and the evaluation of the credibility of competing testimony. In the words of Learned Hand, "[t]he question [is] how the art understood the term, which [is] plainly a question of fact. . . . It is an issue which we are altogether incompetent to decide upon the merits" *Harries v. Air King Prods. Co.*, 183 F.2d 158, 164 (2d Cir. 1950).¹⁰ Indeed, the Federal Circuit has recognized on many occasions that

¹⁰ E.g., *Pall Corp. v. Micron Separations, Inc.*, Nos. 91-1393, *et al.*, 1995 U.S. App. LEXIS 27366, *9-10 (Fed. Cir. Sept. 26, 1995) (whether one of ordinary skill would understand "skinless" in terms of specific pore size and shape or instead as the absence of a visible membrane when viewed through electron microscope); *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993) (whether an "electrical comparator" is the same thing as a computer); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1577 (Fed. Cir. 1992) (whether, in a patent for circuitry in a semiconductor chip, the technical term "overriding the operation" required a current source and a voltage source to be present simultaneously in a circuit); *Tol-O-Matic*, 945 F.2d at 1550 (how much support is implied by term "provide for lateral support" in piston assembly); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 389 (Fed. Cir. 1987) (whether "bottomless trench" design for electrical wiring covered assemblies in which only key portion of the trench was bottomless); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656-57 (Fed. Cir. 1986) (whether term "electrode" included entire length of silver wire, or just tip); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir. 1984) (whether "recovered liquid hydrocarbon absorbent": (1) "means an undefined absorbent that is capable of recovering" liquid hydrocarbon; or (2) "means that the recovered liquid hydrocarbon is being used as an absorbent").

"interpretation of a claim may depend upon evidentiary material about which there is a factual dispute, requiring resolution of factual issues as a basis for interpretation of the claim." *United States v. Teletronics, Inc.*, 857 F.2d 778, 781 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989).¹¹

Even in the decision under review, the Federal Circuit cited — as bearing on the issue of claim construction — the very kind of evidence that, if the subject of a genuine dispute, must be regarded as peculiarly within the jury's domain: expert testimony, "including

¹¹ See also *Arachnid Inc. v. Medalist Mktg. Corp.*, 972 F.2d 1300, 1302 (Fed. Cir. 1992) (although claim construction is issue of law for the court, it "may require the factfinder to resolve certain factual issues such as what occurred during the prosecution history"); *Lemelson v. General Mills Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993) (the "underlying factual issues in dispute become the jury's province to resolve in the course of rendering its verdict on infringement"); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988) (claim "interpretation may depend . . . on evidentiary material which requires resolution of factual issues, such as what occurred during the prosecution history"); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985) (when meaning of claim term is disputed, a "factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction"); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 721-22 n.14 (Fed. Cir. 1984) ("claim construction, dependent on resolution of a factual dispute, does present a jury question").

Pre-Federal Circuit decisions of the regional courts of appeals also recognized that the "proper meaning" of a disputed patent term is "a factual issue to be determined by the jury." *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 770 (5th Cir.), *cert. denied*, 449 U.S. 1022 (1980); see also *Tights, Inc. v. Acme-McCrary Corp.*, 541 F.2d 1047, 1060 (4th Cir.) ("if an issue presents a mixed question of fact and law, it may be submitted if the jury is instructed as to the legal standard to be applied"), *cert. denied*, 429 U.S. 980 (1976); *Continental Conveyor & Equipment Co. v. Prather Sheet Metal Works*, 709 F.2d 403, 406 (5th Cir. 1983) ("the interpretation of the phrase [in the patent] was properly a jury determination"); *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 78 (6th Cir. 1924) ("In case of a controversy as to the construction of a patent claim, it may usually be true . . . that a substantial issue of fact for the jury, resting on extrinsic evidence, is involved."); *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1338 (7th Cir. 1983) ("a factual dispute as to the meaning of a term of art used in the patent claim, the resolution of which required resort to expert testimony, properly would have been submitted to the jury"); *Hall Lab., Inc. v. Economics Lab., Inc.*, 169 F.2d 65, 66-67 (8th Cir. 1948) ("[T]he construction of patent claims where extrinsic evidence is required to determine the meaning of technical terms also involves questions of fact.").

evidence of how those skilled in the art would interpret the claims," 31a (citation omitted); the history of the patent's prosecution in the Patent and Trademark Office, 32a-33a; and other sorts of extrinsic evidence, such as sales literature and testimony of the inventor. 33a.

Resolving disputes over these matters produces a *factual* finding regarding the proper *interpretation* of a patent's terms. This *descriptive* factual finding — what a term actually signifies to the relevant community — in turn informs the *construction* of the document's operative legal effect.¹² To be sure, the latter *normative* determination remains ultimately with the court, but it must — given the Re-Examination Clause — be undertaken in accord with the jury's legally relevant, and oftentimes decisive, findings of fact.

2. In its decision below, the Federal Circuit rejected that conclusion, as well as the Seventh Amendment principles that compel it. The court asserted that, because the ultimate question of patent claim *construction* is a "legal issue," any subsidiary factual questions of claim *interpretation* must be decided by a judge rather than a jury. This reasoning is both demonstrably fallacious and inherently uncontainable. That the legal construction of a patent's scope is, in the end, necessarily a matter of law manifestly does not imply that a judge rather than a jury may decide every issue of disputed fact that arises during the course of claim interpretation — or that a judge may ignore the Re-Examination Clause and determine *de novo* what a patent claim in fact means in the relevant community. Otherwise, all questions of fact that are in the end subsumed in an issue of law — e.g., negligence, causation, or unreasonableness of a restraint of trade — would be tried exclusively to the court.

The Court of Appeals' decision ignores the difference between (a) the traditional Seventh Amendment inquiry into what kinds of *lawsuits* fall outside the historic category of "suits at common law,"

¹² See 3 Arthur L. Corbin, CORBIN ON CONTRACTS § 534 (1960) ("By 'interpretation of language' we determine what ideas that language induces in other persons. By 'construction of the contract,' as that term will be used here, we determine its legal operation — its effect upon the action of courts and administrative officials."); RESTATEMENT (SECOND) OF CONTRACTS § 200 and Comment c (1981) (describing the distinction between "construction" and "interpretation" as reflecting the difference between the "meaning" of a term and its "legal effect"); see also 86a-92a (Newman, J., dissenting).

such that no jury trial right attaches; and (b) the entirely novel inquiry (which is incompatible with the Seventh Amendment) into what kinds of *factual disputes*, embedded within lawsuits undeniably falling inside the historic jury-trial category,¹³ nonetheless appear so "legal" in character that those facts may be decided by the court rather than the jury.

The first inquiry is a familiar one that focuses on the nature of the litigation, including both the cause of action involved and the remedy sought. See *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990); *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989). But the second, newly minted inquiry is incoherent from start to finish, inasmuch as *every* factual issue that arises in any trial must of necessity arise because it has some relevance to — that is, some logical bearing upon — a question of law that in turn governs, or at least contributes to, the resolution of the ultimate dispute.

Even under the first, conventional kind of Seventh Amendment inquiry, this Court has made clear that the right to jury trial on factual issues cannot be lost simply because those issues are submerged in legal or equitable questions to be resolved by a court. Thus, after lower courts had held that the presence of an equitable issue could eliminate the need to try a lawsuit before a jury,¹⁴ this Court intervened to clarify that, when claims for damages are joined with a request for equitable relief, the right to jury trial, "including all issues common to both claims, remains intact." *Curtis v. Loether*, 415 U.S. 189, 196 n.11 (1974) (discussing *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959)).

Just as lower courts, pre-*Beacon Theatres*, had erroneously held that a "dash of equity" could extinguish the right to jury trial, so the

¹³ Judge Newman, in dissent below, ably showed that patent infringement actions were tried before a jury at common law, 118a-129a, a conclusion that the majority did not dispute. 44a. See generally *Coupe v. Royer*, 155 U.S. 565, 579-80 (1895); *Royer v. Schultz Brewing Co.*, 135 U.S. 319, 325 (1890); *Tyler v. Boston*, 74 U.S. (7 Wall.) 327, 330-31 (1869).

¹⁴ E.g., 9 Charles Alan Wright & Arthur Miller, FEDERAL PRACTICE & PROCEDURE § 2302.1 (1973 & 1995 supp.).

Federal Circuit, ignoring *Beacon Theatres* and *Dairy Queen*, has now held that the presence of a legal question, suitably mixed with the facts in dispute, could do the same. This error is even more egregious than that which led this Court to issue its course correction in *Beacon Theatres*, for "it would hardly take extraordinary ingenuity for a lawyer to find" questions of law mixed with questions of fact "at every turn in the road." *Sugarman v. Dougall*, 413 U.S. 634, 657 (1973) (Rehnquist, now C.J., dissenting). Thus, the Federal Circuit committed a truly fundamental constitutional error by failing to recognize that legally relevant questions of fact about which there is a genuine dispute are *always* subject to the jury-trial right whenever the controversy in which the dispute arises is jury-triable under the Seventh Amendment — regardless of how the facts fit into, or mix with, the legal matrix of the overall controversy.

3. The Federal Circuit's decision violates *both* clauses of the Seventh Amendment. As one scholar has commented, transforming issues of "fact" into "law" is "drastic in that it amounts to a direct judicial assault on the prerogatives of fact finders."¹⁵ The "classification of ultimate facts as questions of law amounts to a manipulation of the law-fact doctrine to take questions from the jury or to subject the trial level's resolution of questions to free appellate review."¹⁶ This Court has repeatedly made clear that the first clause of the Seventh Amendment "requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Walker v. New Mexico Railroad Co.*, 165 U.S. 593, 596 (1897); *see also Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494, 498 (1931).

The decision below also violates the second clause of the Seventh Amendment in cases like this one where a jury has already been entrusted with the responsibility of deciding disputed factual issues, such as the meaning that the relevant scientific community would

¹⁵ Martin B. Louis, *Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion*, 64 N.C. L. REV. 993, 1018 (1986).

¹⁶ *Id.* at 1028.

assign to a highly technical patent claim term. Here, the jury was instructed to "determine the meaning of the claims . . . using the relevant patent documents" and "other considerations that show how the terms of a claim would normally be understood by those of ordinary skill in the art." 13a. The Federal Circuit subsequently held that it was free to re-decide that very question.

But the Re-Examination Clause, which this Court has long held to be a "substantial and independent clause" that is even "more important" than the preceding portion of the Amendment, *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.), "not only preserves th[e] jury trial] right but discloses a studied purpose to protect it from *indirect impairment* through possible enlargements of the power of reexamination existing under the common law." *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935) (emphasis added); *see also Colgrove v. Battin*, 413 U.S. 149, 155 n.6 (1973).

The Re-Examination Clause was inserted into the Seventh Amendment in order to address "the vexing problem of appellate review of questions of fact." Wolfram, *supra* n.6, at 727. Indeed, the Seventh Amendment as a whole strikes a balance between the power of the jury and the power of the courts — particularly "appellate courts." Higginbotham, *supra*, at 50. "[T]he right to a jury trial and the corresponding limitation on appellate courts' review of fact were foremost in the minds of the Framers." J. Wilson Parker, *Free Expression and the Function of the Jury*, 65 B.U. L. REV. 483, 498 (1985).

The interference with the colonists' right to jury trial had been "one of the important grievances leading to the break with England." *Parkland Hosiery*, 439 U.S. at 340 (Rehnquist, now C.J., dissenting). Among the colonists' complaints were the extension of the jurisdiction of the reorganized courts of admiralty and vice-admiralty¹⁷ and the assertion of appellate review by the Privy Council

¹⁷ 11 W. Holdsworth, *A HISTORY OF ENGLISH LAW* 110 (1966); *see also Duncan v. Louisiana*, 391 U.S. 145, 152 (1968) ("Royal interference with the jury trial was deeply resented."); Carl Ubbelohde, *THE VICE-ADMIRALTY COURTS AND THE AMERICAN REVOLUTION* 210 (1960) ("the colonists came to believe passionately about this loss of jury trial"). Although these courts originally dealt with criminal offenses, "their jurisdiction was also extended to many areas of the civil law."

in London, which claimed the authority to disallow acts of colonial legislatures and overturn verdicts of colonial juries and judgments of colonial courts. 1 Homer Carey Hockett, *THE CONSTITUTIONAL HISTORY OF THE UNITED STATES* 55 (1939) (Council reviewed some 265 colonial cases). The colonists found this practice "expensive, dilatory, and vexatious." Roscoe Pound, *THE DEVELOPMENT OF CONSTITUTIONAL GUARANTEES OF LIBERTY* 77 (1957). The Council rejected attempts by the colonies to preserve the finality of their own judicial judgments.¹⁸ Such arbitrary review contributed to the colonists' belief that they were the victims of a remote, "centralized administration at Westminster which continually neglected or even positively injured [their] interests." *Id.* at 71; see also Bernard Bailyn, *THE ORIGINS OF AMERICAN POLITICS* 67-70 (1968).

The lesson was not forgotten during the framing of the Constitution and Bill of Rights. Opponents of the Constitution argued that "[e]very new tribunal erected for the decision of facts, without the intervention of a jury, . . . is a step toward establishing aristocracy." 4 *THE COMPLETE ANTI-FEDERALIST* 214 (H. Storing ed. 1981). Hamilton assured skeptics that the extension of "appellate jurisdiction" to "matters of fact" would not work "an implied supersedure of the trial by jury." *THE FEDERALIST* NO. 83, at 509 (H. Lodge ed. 1888). The Judiciary Act of 1789 stressed the jury's province over factual issues¹⁹ and flatly prohibited appellate review of these issues.²⁰

Parkland Hosiery, 439 U.S. at 341 (Rehnquist, now C.J., dissenting). Accordingly, "[t]he extensive use of vice-admiralty courts by colonial administrators to eliminate the colonists' right of jury trial was listed among the specific offensive English acts denounced in the Declaration of Independence." *Id.* at 340.

¹⁸ Colonial legislatures sought to bar review altogether, limit the time for appeals to the Privy Council, or limit the cases in which they might be brought. See Hockett, *supra*, at 54; Pound, *supra*, at 77. The Privy Council disregarded such attempts, reviewing some 50 cases on petition after colonial courts had refused to grant leave to appeal. See Hockett, *supra*, at 55 n.12.

¹⁹ "And the trial of issues in fact, in the district courts, in all causes except civil causes of admiralty and maritime jurisdiction, shall be by jury." 1 Stat. 77; see also 1 Stat. 81 (circuit courts); 1 Stat. 82 (Supreme Court).

²⁰ 1 Stat. 84-85; see also Parker, 65 B.U. L. REV. at 499 ("the congressional debate surrounding the Judiciary Act of 1789 shows the concern of the founding

The Federal Circuit's assertion of a *de novo* power to review determinations turning on credibility and the weighing of evidence flies in the face of this historical tradition. Indeed, nowhere else in the law does an appellate court wield such a singular power, and there is no indication that Congress, in creating the Federal Circuit, imagined that this Court of Appeals would possess it. In fact, Congress was assured that "the problem being addressed is at the appellate level, where the concern is the law, and only very rarely, if ever, the facts."²¹ The Committee reports warned that the Federal Circuit would not be permitted to supplement its own authority.²² Yet the decision under review represents a dramatic expansion of the Federal Circuit's power.

4. Not surprisingly, the Federal Circuit's decision is in square conflict with decisions of this Court, which have long recognized that underlying factual disputes regarding the construction of a patent claim are to be resolved by a jury where it is the trier of fact. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), for example, this Court concluded that the trial court properly "left . . . matter[s] of

fathers that elimination of the jury would result in a shift of power, not to the trial judge, but to the appellate courts"); Charles Warren, *New Light on the History of the Federal Judiciary Act of 1789*, 37 Harv. L. Rev. 49, 102-04 (1923) (discussing narrow scope of "writ of error").

²¹ *Hearings on the Federal Courts Improvement Act of 1979 Before the Senate Judiciary Subcommittee on Improvements in Judicial Machinery*, 96th Cong., 1st Sess. 114 (1979) (statement of Chief Judge Markey); see also H.R. Rep. No. 312, 97th Cong., 1st Sess. 18-19 (1981) ("the United States Court of Appeals for the Federal Circuit is an Article III court at the same level as the existing circuit courts of appeals. The new court will function like these other appellate courts . . . [T]he proposed new court is not a 'specialized court.'"); S. Rep. No. 275, 97th Cong., 1st Sess. 2, 6 (1981) (the Federal Circuit is an "Article III court that is similar in structure to the twelve other courts of appeals. . . . [It] will not be a 'specialized court'. . . ."), reprinted in 1982 U.S. CODE CONG. & ADMIN. NEWS 12, 16.

²² See S. Rep. No. 275, 97th Cong., 1st Sess. 4 (1981) ("[I]t is not the Committee's judgment that broader subject matter jurisdiction is intended for this court," and "any additional subject matter for the United States Court of Appeals for the Federal Circuit will require not only serious future evaluation, but new legislation."), reprinted in 1982 U.S. CODE CONG. & ADMIN. NEWS 14 (emphasis added).

fact to the jury" in construing a patent claim. *Id.* at 225.²³ Similarly, in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), this Court held that a prior patent and related expert testimony on the issue of "diversity or identity" were improperly withheld from the jury, and described the issue as a "mixed question of law and fact" that "must be submitted to the jury, if there is so much resemblance as raises the question at all." *Id.* at 455. In *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), the trial court "construed" the claim in a general manner and left it for the jury to fill in the specifics. This Court affirmed the trial court's refusal to define the patent claim in its entirety, explaining that "where the whole substance of the invention may be copied in a different form, it is the duty of the courts and juries to look through the form for the substance of the invention — for that which entitled the inventor to his patent, and which the patent was designed to secure." *Id.* at 343 (emphasis added).²⁴

²³ *Silsby* involved an appeal from a jury trial regarding a patent for an improvement in regulating the draft of stoves. The trial court determined that the patent covered "a combination of such of the described parts as were combined and arranged for producing a particular effect, viz., to regulate the heat of the stove." 55 U.S. (14 How.) at 225. But this legal construction of the patent claim still left some factual dispute as to the meaning of the patent's terms: what parts were necessary to regulate the heat of a stove? Accordingly, the trial court left to the jury the initial question of precisely which parts were covered by the claim as construed by the court. The defendants objected, "desir[ing] the Judge to instruct the jury that the index, the detaching process, and the pendulum, were constituent parts of this combination." *Id.* But this Court rejected that challenge: "How could the Judge know this as a matter of law? . . . [I]t therefore became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into, and constitute an essential part of this combination." *Id.* at 226.

²⁴ The Federal Circuit maintained (at 34a) that cases like *Silsby* are no longer applicable in the wake of 35 U.S.C. § 112, which requires patentees to set out specifications of their claims. See Part II-B, *infra*. But the statute represented less of a change than the court thought, since even the first Patent Act, in 1790, required that letters patent "describ[e] the said invention or discovery, clearly, truly, and fully." See 74a-75a (Mayer, J., concurring in the judgment); 131a-135a (Newman, J., dissenting). Moreover, the majority's logic is a *non sequitur*. Even if the adoption of § 112 reduced the incidence of genuine factual disputes of the kind that arose in *Silsby*, it would not alter the fact that, when such disputes occur, they must be resolved by the jury. See *Granfinanciera*, 492 U.S. at 51 (even Congress "lacks the power to strip parties contesting matters of private right of their constitutional right to a trial by jury").

Only when interpretation of patent claims presents no factual question has this Court permitted federal judges to construe them as a matter of law.²⁵ A noted commentator explained that, "[w]hen the Claim itself refers to facts, the existence and character of which must be determined before the Claim can be construed, evidence concerning these facts may be submitted to the jury, whose finding thereon thus enters into and becomes an element in the interpretation of the Claim."²⁶

5. The submergence of factual questions within an ultimately legal issue is not limited to claim interpretation. Patent law is replete with issues that are ultimately *legal* in nature, but which contain subsidiary *factual* questions that must be resolved by a jury when it is the trier of fact. Thus, the novel principle announced by the Federal Circuit threatens the role of the jury in a wide range of patent cases — and in federal civil litigation generally, for there is no logical basis to limit the principle to patent suits.

This Court has recognized that, "[w]hile the ultimate question of patent validity is one of *law*, the § 103 condition [whether one of ordinary skill would find the patent 'nonobvious'] . . . lends itself to several basic *factual* inquiries." *Graham v. John Deere Co.*, 383

²⁵ See, e.g., *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1903) ("it is apparent from the face of the instrument that extrinsic evidence is not needed"); *Heald v. Rice*, 104 U.S. 737, 749 (1881) ("if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art . . . then the question of identity is one of pure construction, and not of evidence"); *Brown v. Piper*, 91 U.S. 37, 41, 44 (1875) (although evidence had been taken at trial, "[w]e think the patent was void on its face, and that the court might have stopped short at that instrument"); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1858) (there was only one construction of the patent "which the language of this specification will admit"); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848) ("without the aid of experts and machinists, [we have] no difficulty in ascertaining, from the language used here, the meaning of the patent").

²⁶ 3 William C. Robinson, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 1037 (1890) (emphasis added) (hereafter "ROBINSON ON PATENTS"); see also A.H. Walker, *TEXTBOOK ON THE PATENT LAWS OF THE UNITED STATES OF AMERICA* § 536 (4th ed. 1904) ("Where the question of infringement depends on the construction of the patent, and that construction depends upon a doubtful question in the prior art, the latter question should be left for the jury; and the dependent question of infringement should also be left for the jury to decide.").

U.S. 1, 17 (1966) (emphasis added). Those inquiries concern: "(1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art at the time when the invention was made; and (4) objective evidence of nonobviousness." *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 989 (Fed. Cir. 1988).

Similarly, this Court has held that the question of infringement under the doctrine of equivalents²⁷ is an issue of fact to be submitted to the jury. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609-10 (1950) ("A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including tests and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence."). The Federal Circuit recently reaffirmed that settled rule in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1521 (Fed. Cir. 1995) (*en banc*) (*per curiam*), although the court came within two votes of departing from it. Thus, under the decision below, a dispute regarding claim interpretation in an action alleging literal infringement is deemed to involve an issue of law, while interpretation of the same claim language under the doctrine of equivalents is left to the jury.

Other components of a patent's legal validity turn on additional underlying questions of fact. These include anticipation, *see, e.g., Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1573 (Fed. Cir. 1984), and prior public use or sale. *See, e.g., U.S. Envtl. Prods. v. Westall*, 911 F.2d 713, 715 (Fed. Cir. 1990).²⁸

²⁷ The doctrine of equivalents holds that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same [for patent infringement purposes], even though they differ in name, form, or shape." *Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877).

²⁸ The legal issue of a patent's enforceability also includes subsidiary factual questions. *See Therma-Tru*, 44 F.3d at 994-95 (reversing district court's finding that patent was unenforceable because "[t]he trial judge appears to have viewed himself as a jury of one, finding the facts of materiality and intent and applying the law to those facts. . . . Although the district court stated that 'the court served as factfinder' with respect to materiality and intent, the court may not make findings in conflict

In short, there is no principled way to distinguish the process of fact-finding used to resolve disputes regarding claim interpretation from the fact-finding employed in these other contexts in patent law. The precedential dangers of the Federal Circuit's decision are plain.

II. THE BASES OF THE FEDERAL CIRCUIT'S DECISION ARE FLAWED

A. The Seventh Amendment Cannot Be Circumvented by Resorting to A Strained Analogy Between Patents and Statutes

A principal basis of the Federal Circuit's decision was an ill-considered analogy between patents and statutes. 51a-52a. The court's reasoning was flawed.

1. The analogy between patents and statutes is misplaced. Patents are not "baby statutes," 80a n.8 (Mayer, J., concurring in the judgment), and the Patent and Trademark Office is not some "sort of junior-varsity Congress." *Mistretta v. United States*, 488 U.S. 361, 427 (1988) (Scalia, J., dissenting). For example, although a legislature is open and accountable to all, *see, e.g., Bi-Metallic Inv. Co. v. State Bd. of Equalization*, 239 U.S. 441, 445-46 (1915), the patent process is essentially private. *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279 (1877) ("patents are procured ex parte").

The Federal Circuit observed that patents are usually "enforceable against the public." 51a. But, of course, so are property rights and private contracts.²⁹ Moreover, the enforceability

with those of the jury [citing *Beacon Theatres*]. . . . In this case, the determinations of the jury and judge were simultaneous. However, this does not authorize judicial findings independent of and contrary to the facts found by the jury in reaching its verdict."); *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212-13 (Fed. Cir. 1987) (where factual issues relating to a legal claim for patent infringement are common with those relating to a defense of unenforceability based on inequitable conduct by the patentee, the jury must be allowed to decide the question of patent validity and the court's findings regarding inequitable conduct must be made in light of the jury's decision).

²⁹ For example, almost all States recognize that third parties may not tortiously interfere in a private contractual relationship. *See* RESTATEMENT (SECOND) OF

of patents against third parties is dictated by rules of issue preclusion, not by the nature of a patent claim.³⁰ Thus, under the decision below, two different panels of the Federal Circuit would be free, on their *de novo* review, to provide two contradictory interpretations of the same patent claim if two different infringers were involved in the two cases. If the first infringer were not a party to the first case, it could not be bound by that judgment. See, e.g., *Martin v. Wilks*, 490 U.S. 755, 762 (1989)

2. Given the flaws in the analogy between patents and statutes, this Court has viewed patents as instead analogous to contracts or privately written deeds to property. Any factual disputes bearing on ambiguities in these written instruments are resolved by the jury, not the court.³¹

As this Court has long recognized, a patent resembles a contract between the inventor and the government.³² In return for full

TORTS § 766 (1979); 43 Am. Jur.2d *Interference* §§ 12, 23, 29, 30, 31, 40, 57 (1968 & 1994 supp.); Annot., *Liability of Third Party for Interference With Prospective Contractual Relationship Between Two Other Parties*, 6 A.L.R.4th 195 (1994). In addition, the Federal Circuit's attempt to distinguish contract enforcement as an essentially "private" activity is unsustainable in light of the last half-century of state action doctrine. See, e.g., *Barrows v. Jackson*, 346 U.S. 249, 254 (1953); *Shelley v. Kraemer*, 334 U.S. 1, 19-20 (1948).

³⁰ Under *Triplett v. Lowell*, 297 U.S. 638 (1936), patent validity could be relitigated in successive actions. It was only this Court's decision in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971), that altered the rule of mutuality of estoppel. See *Cardinal Chemical Co. v. Morton Intern., Inc.*, 113 S. Ct. 1967, 1977 (1993).

³¹ See, e.g., Samuel Williston, A TREATISE ON THE LAW OF CONTRACTS § 616, at 649, 652 (3d ed. 1961) ("The general rule is that interpretation of a writing is for the court. . . . Where, however, the meaning of a writing is uncertain or ambiguous, and parol evidence is introduced in aid of its interpretation, the question of its meaning should be left to the jury"); see also *Reed v. Proprietors of Locks & Canals on Merrimac River*, 49 U.S. (8 How.) 274, 289 (1850) (jury's task to interpret vague or ambiguous deed).

³² See, e.g., *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (noting, in discussing construction of a patent, that "[t]he understanding of a party to a contract has always been regarded as of some importance in its interpretation"); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993) ("While there may be underlying fact questions

disclosure of the best mode of the invention in sufficient detail to enable one skilled in the relevant art to practice it and thus improve upon it, the government grants the patentee a restricted monopoly for a period of time. See *Hilton Davis*, 62 F.3d at 1529 (Newman, J., concurring). The sort of extrinsic evidence used in interpreting contracts is the same kind of evidence used in interpreting patent claims: custom and usage of the trade and course of dealing between the parties (akin to prior art), level of skill in the art, and events in the Patent and Trademark Office.

Alternatively, a patent may be thought of as a form of deed which sets out the metes and bounds of the intellectual property the inventor owns for the term and puts the world on notice either to avoid trespass or to purchase all or part of the property right it represents.³³ Just as juries interpret contested boundary descriptions, so they must decide similar issues where the boundary surrounds a patent claim rather than a land or mining claim. See *Reed*, 49 U.S. at 289 ("A deed may be vague, ambiguous, and uncertain in its description of boundary; and even when it carefully sets forth the lines and monuments, disputes often occur as to where those lines and monuments are situated on the ground; and it necessarily becomes a fact for the jury to decide, whether the land in controversy is included therein, or, in other words, was intended by the parties so to be.").

3. In any event, the Federal Circuit's analogy did not prove what the Court of Appeals assumed it did. The process of interpreting a patent's scope, when the issue is what the relevant scientific community would understand a particular term to mean at the time of the patent's issuance, involves weighing evidence and evaluating credibility bearing on what ideas the patent's language induces in other persons. It is simply incoherent to treat that question as though

involved, the ultimate conclusion about the meaning and scope of a claim is, *like contract interpretation*, a question of law") (emphasis added); 1 ROBINSON ON PATENTS at §§ 15, 20 (explaining the longstanding analogy between patents and contracts, which originated in England in 1800 and was adopted in this country in 1831).

³³ See, e.g., *Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917).

it involved a *legal* one — *i.e.*, the effect that *ought* to be given to a particular written instrument. The process involves resolution of a dispute over adjudicative facts — precisely the kind of task that is entrusted to the jury, even in cases arising under federal statutes.

Consider, for example, a federal statute analogous to the patent at issue in *Silsby v. Foote* — that is, a federal statute that created a civil cause of action for persons injured by defects in parts of stoves shipped in interstate commerce if those parts are "necessary to regulate the heat of the stove." See p.16, n.23, *supra*. A defendant in a case brought under such a statute would be entitled to have a jury consider the defense that the particular element of the stove that had injured the plaintiff was *not* one that was "necessary to regulate the heat of the stove," so long as there was a genuine factual dispute over the matter. See *Lytle v. Household Mfg., Inc.*, 494 U.S. 545, 550 (1990); *Curtis v. Loether*, 415 U.S. at 196 n.11.

The example is not merely hypothetical. The securities laws require a jury to determine, as a "mixed question of law and fact," whether a given statement was "material" within the meaning of relevant federal statutes. *United States v. Gaudin*, 115 S. Ct. 2310, 2314 (1995). "[T]he materiality inquiry, involving as it does 'delicate assessments of the inferences a "reasonable [decision-maker]" would draw from a given set of facts and the significance of those inferences to him . . . [is] peculiarly on[e] for the trier of fact.'" *Id.* at 2314-15 (quoting *TSC Industries, Inc. v. Northway, Inc.*, 426 U.S. 438, 450 (1976)). Similarly, in admiralty law, "the underlying inquiry whether a vessel is or is not 'in navigation' for Jones Act purposes is a fact-intensive question that is normally for the jury and not the court to decide." *Chandris, Inc. v. Latsis*, 115 S. Ct. 2172, 2192 (1995); see also *McDermott Intern., Inc. v. Wilander*, 498 U.S. 337, 355 (1991) ("Member of a crew" and 'seaman' are statutory terms," but "seaman status under the Jones Act is a question of fact for the jury"). Other federal statutes operate in similar fashion.³⁴

³⁴ For example, 15 U.S.C. § 1221(a) requires juries to determine whether an entity "acts for" an automobile manufacturer or is "under [its] control" — and thus is subject to liability in suits by dealers. See, e.g., *Colonial Ford, Inc. v. Ford Motor Co.*, 592 F.2d 1126, 1129 & n.3 (10th Cir.), *cert. denied*, 444 U.S. 837 (1979). Copyright law vests the jury with authority to determine "substantial and

With respect to patents as with respect to many statutes, the pre-existing substantive law, ultimately under the control of Congress, makes the interpretation of the terms of art employed in the instrument turn on what those schooled in the relevant fields would take those terms to mean at a given time. To the degree that the construction of a statute is instead deemed, as a matter of law, to be independent of the probable or actual understanding of those governed by it, this separation of legal construction from factual interpretation must, not only as a matter of common sense but indeed as a matter of fundamental fairness and due process, be derived from a pre-existing substantive rule of construction that is clear enough to give fair warning to all those who might be held legally accountable for assuming the contrary. See *Marks v. United States*, 430 U.S. 188, 191 (1977); *Connally v. General Constr. Co.*, 269 U.S. 385, 391 (1939).

Accordingly, the frequent irrelevance of adjudicative factfinding in statutory construction is a function not of anything magical about statutes that those instruments might have in common with patents, but rather of pre-existing rules of construction informing the world that statutes will not always be taken to mean what their addressees in fact suppose — rules that have no counterpart in patent construction and rules that no federal court would have constitutional authority to promulgate.³⁵ Even if a patent could properly be

material similarity" and other mixed questions of fact and law in infringement actions. See, e.g., *Rexnord, Inc. v. Modern Handling Systems, Inc.*, 379 F. Supp. 1190, 1196 (D. Del. 1974); *Blunt v. Patten*, F. Cas. No. 1579 (C.C.N.Y. 1828). Suits under 42 U.S.C. § 1983 involve a host of factual determinations submerged within legal questions as well. See, e.g., *Brisk v. Miami Beach*, 726 F. Supp. 1305, 1306 n.3 & 1309 (S.D. Fla. 1989) (application of qualified immunity in Fourth Amendment § 1983 case is a mixed question of law and fact that should be submitted to a jury); *Medcalf v. Kansas*, 626 F. Supp. 1179, 1188 (D. Kan. 1986) (whether failures of training and supervision amounted to gross negligence was a question of fact to be decided by jury in § 1983 case); *Morgan v. Labiak*, 368 F.2d 338, 340 (10th Cir. 1966) (reasonableness of force used by police officer is a question of fact for the jury).

³⁵ Cf. Michael C. Dorf, *A Comment on Text, Time and Audience Understanding in Constitutional Law*, 73 WASH. L.Q. 983, 983 & n.1 (1995) (discussing how the legal landscape might change if the courts interpreted statutes and constitutional provisions to reflect average citizens' understanding of their language).

analogized to a statute, therefore, interpretation of a patent's meaning and scope in the course of a damage suit for patent infringement would necessarily remain a matter for a jury to decide.

4. Nor could the judgment below be defended on the ground that patents involve matters of "public right." *Crowell v. Benson*, 285 U.S. 22, 50-51 (1932). Accepting such an argument would call into question the right to jury trial not merely with respect to claim interpretation, but with regard to *all* aspects of patent litigation. See n.8, *supra*. Even if this Court were willing to reach the question of whether patents could be described as involving "public rights,"³⁶ and even if this Court were willing to depart from its previous unwillingness to make constitutional principle turn on "doctrinaire reliance on formal categories" of "public" and "private" rights,³⁷ the "public rights" doctrine has nothing to do with this case. Whatever Congress' power might be to assign patent infringement suits to administrative agencies for resolution, see *Granfinanciera*, 492 U.S. at 42 n.4; *Northern Pipeline Construction Co. v. Marathon Pipe Line Co.*, 458 U.S. 50, 70 (1982) (plurality opinion), Congress has obviously taken no such action. Accordingly, even assuming *arguendo* that patents confer purely public rights, litigation concerning those rights, when it is brought in an Article III court, continues to be subject to the protections of the Seventh Amendment.

³⁶ Compare *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604, modified on reh'g, 771 F.2d 480 (Fed. Cir. 1985) (patent involves public right), with *Pacemaker Diagnostic Clinic of America, Inc. v. Instromedix, Inc.*, 725 F.2d 537, 541 (9th Cir.) (*en banc*), cert. denied, 469 U.S. 824 (1984) (proceeding from contrary premise). In *Ex parte Bakelite Corp.*, 279 U.S. 438, 452 (1929), this Court described public rights cases involving as "claims against the United States" for "money, land, or other things." *Id.* at 452. In *Granfinanciera*, this Court defined "private right" as "the liability of one individual to another under the law as defined," in contrast to cases that "arise between the Government and persons subject to its authority." 492 U.S. at 50 n.8 (quoting *Crowell*, 285 U.S. at 50, 51). These definitions would exclude from the "public rights" category a suit by one private party against another for patent infringement, just as a private suit for trespass on a government land grant would not be a "public rights" case.

³⁷ *Thomas v. Union Carbide Agricultural Prods. Co.*, 473 U.S. 568, 587 (1985); see also *CFTC v. Schor*, 478 U.S. 833, 853 (1986) ("this Court has rejected any attempt to make determinative for Article III purposes the distinction between public rights and private rights").

Chauffeurs, 494 U.S. at 565 n.4. There is no occasion for this Court to decide here whether Congress has the constitutional authority to assign patent disputes to administrative tribunals, when Congress has declined to exercise any such power it might have in that regard.

B. The Decision Below Cannot Be Defended By Assuming That 35 U.S.C. § 112 Requires Claims to Be Written So That They Are Not Ambiguous to Lawyers

The Federal Circuit believed that 35 U.S.C. § 112³⁸ "has as its purpose the avoidance of the kind of ambiguity that allows introduction of extrinsic evidence in the contract law analogy." 49a. There is no basis for supposing that § 112 could be used to avoid the constitutional question this case poses. Any such argument would ignore this Court's holding — now a basic rule of patent law — that patents are addressed to those skilled in the art, not to lawyers. Because the degree of precision required for a given claim will depend on the subject matter involved, claims may at times contain some measure of (often unavoidable) ambiguity due to the nature of the invention — but will not be found fatally indefinite on that account so long as one skilled in the relevant art could reasonably know the bounds of the claim. *Carnegie Steel Co.*, 185 U.S. at 437 ("The specification of the patent is not addressed to lawyers, or even to the public generally, but to [those skilled in the art], and any description which is sufficient to apprise them in the language of the art of the definite feature of the invention, and to serve as a warning to others of what the patent claims as a monopoly, is sufficiently

³⁸ Section 112 provides, in pertinent part, that a patent specification

shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor in carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

definite to sustain the patent.")³⁹

Prior to the decision under review, the Federal Circuit had long recognized that interpreting a patent claim requires a factual inquiry into how one of ordinary skill at the time of the invention would have understood the term, and that resulting factual disputes are matters for the jury. See n.11, *supra*. Even in its decision below, the Federal Circuit acknowledged that § 112 does not eliminate the "need for extrinsic evidence" in interpreting patent claims. 50a.

Indeed, § 112 itself creates the need for juries to find facts and resolve evidentiary disputes in order to establish how much detail and clarity a claim should be required to have. Such evidentiary questions typically concern the prior art, the particular invention, and how the claims would be read by those of ordinary skill in the relevant art.⁴⁰ For example, "[a]lthough the question of whether [a] specification contains a sufficient disclosure under 35 U.S.C. § 112 para. 1 is one of law, compliance with the written description aspect of that requirement is a question of fact." *Utter v. Hiraga*, 845 F.2d

³⁹ See also *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) ("The degree of precision necessary for adequate claims is a function of the nature of the subject matter."); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987) (noting that claims satisfied § 112, even though they were "not precise," because they were "as precise as the subject matter permits" and "reasonably apprise[d] those skilled in the art"). *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124, 136 (2d Cir.), *cert. denied*, 358 U.S. 884 (1958) ("the [patent] claims, read in the light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can do no more").

⁴⁰ See, e.g., *Credle v. Bond*, 25 F.3d 1566, 1576 (Fed. Cir. 1994) (stating rule that determining whether claim is indefinite requires analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification); *Hormone Research Found. v. Genentech, Inc.*, 904 F.2d 1558, 1567 (Fed. Cir. 1990) (reversing grant of summary judgment on § 112 because of existence of disputed issues of fact), *cert. dismissed*, 499 U.S. 955 (1991); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) ("A decision on whether a claim is invalid under [§ 112] requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.").

993, 998 (Fed. Cir. 1988).⁴¹ In addition, "although enablement" — *i.e.*, whether the patent is sufficiently clear to enable someone skilled in the art to make and use the claimed invention — "is ultimately a question of law," the Federal Circuit "has recognized that there may be underlying factual issues involved." *Spectra-Physics v. Coherent*, 827 F.2d 1524, 1533 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987).⁴² Section 112 also requires that a patent specification disclose the "best mode" contemplated by the inventor of carrying out the invention — a mandate that generates still more issues of fact resolvable by a jury.⁴³

Section 112 thus does not eliminate the need for a jury to resolve factual disputes relating to claim interpretation. Indeed, it creates additional issues to be submitted to the jury.

C. No Policy Concerns Could Possibly Justify Violating The Seventh Amendment

1. Even if it were possible for concerns rooted in policy or utility to justify ignoring commands of constitutional principle, there could be no policy reason for tolerating the Federal Circuit's abrogation of the Seventh Amendment. The Federal Circuit apparently was motivated by the desire to liberate patent litigation from what it took to be the "unpredictability" of jury verdicts. Yet prior to *Markman*,

⁴¹ See also *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 865 (Fed. Cir. 1993) ("Whether the written description requirement has been met is a question of fact."); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (same).

⁴² See also *Christian v. Colt Industries Operating Corp.*, 822 F.2d 1544, 1564 (Fed. Cir. 1987) (noting that the assertion that disclosures "do not enable one skilled in the art to practice the inventions" need to be proven with "testimony" and "evidence"), *vacated and remanded on other grounds*, 486 U.S. 800 (1988); *Quaker City Gear Works, Inc. v. Skil Corp.*, 747 F.2d 1446, 1453-54 (Fed. Cir. 1984) ("The question of whether the disclosure of a patent satisfies the enablement requirement of § 112 . . . is a question of law. However, that issue may involve subsidiary questions of fact . . .") (citation omitted), *cert. denied*, 471 U.S. 1136 (1985).

⁴³ See *Therma-Tru Corp. v. Peachtree Doors, Inc.*, 44 F.3d 988, 993 (Fed. Cir. 1995) (observing that whether patentee satisfied "best mode" requirement of § 112 "is a question of fact" and approving jury instruction on the issue).

the Federal Circuit (and previously the regional courts of appeals) had often held that underlying factual questions regarding claim construction were to be decided by a jury. See n.11, *supra*. There is no evidence that this system was unworkable.

In any event, courts could take simple steps to address this perceived problem without violating the Seventh Amendment. Trial judges can exclude expert testimony if it fails the standards outlined in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. 2786 (1993). They can make complex issues more accessible to jurors.⁴⁴ And, of course, they can grant summary judgment or judgment as a matter of law if there is no *genuine* factual dispute as to claim interpretation (or any other issue). See, e.g., *Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031, 1034 (Fed. Cir. 1992) ("Without factual disputes, claim interpretation proceeds as a matter of law."); *Key Mfg. Group, Inc. v. Microdot, Inc.*, 925 F.2d 1444, 1448 (Fed. Cir. 1991) (in the absence of a factual issue, proper interpretation of a claim is "a question of law freely reviewable by this court on appeal"); *Palumbo*, 762 F.2d at 974 ("If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law.").

There is simply no basis in the Constitution, or in any positive legal enactment, for carving an ill-defined "patent exception" into the Seventh Amendment comparable to the amorphous "complexity exception" that lower courts have properly rejected.⁴⁵ Disputes about scientific evidence, expert testimony, and technological issues are hardly unique to patent cases. After all, *Daubert* was a products liability case. And the need for "predictability" is no greater in patent cases than it is in many other commercial disputes, or in

⁴⁴ See, e.g., *Manual for Complex Litigation (Third)* §§ 21.633, 22.45 (1995) (recommending special verdicts or interrogatories); Fed. R. Evid. 706 (court-appointed experts); Brookings Institution, CHARTING A FUTURE FOR THE CIVIL JURY 18-20 (1992) (allowing jurors to take notes and pose questions through the judge; using information technology to give jurors access to transcripts and exhibits to aid in comprehension).

⁴⁵ E.g., *In re Financial Securities Litig.*, 609 F.2d 411, 427-31 (9th Cir. 1979), cert. denied, 446 U.S. 929 (1980); *Kian v. Mirro Aluminum Co.*, 88 F.R.D. 351, 355 (E.D. Mich. 1980); *Radial Lip Mach., Inc. v. International Carbide Corp.*, 76 F.R.D. 224, 227-29 (N.D. Ill. 1977).

litigation generally. Yet different juries are permitted to reach different interpretations of the same contract, for example, or different conclusions about whether a given act was negligent.

2. Nor is there any basis for assuming that transforming claim interpretation into a legal issue will produce uniformity. Initially, the task of claim construction will rest with federal district judges, who surely lack the time and resources available to become patent experts and who generally do not possess the requisite technical background to interpret obscure scientific terms. Indeed, the Federal Circuit had occasion to reverse the construction of patent claims by a district judge who "candidly express[ed] considerable difficulty in understanding the chemistry and law involved in the case." *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995). In another recent case, the Federal Circuit held that the jury had applied the correct construction of patent claims, but that the district court had adopted an erroneous construction. *Laitram Corp. v. NEC Corp.*, 62 F.3d 1388, 1394 (Fed. Cir. 1995). These examples hardly inspire confidence in the ability of district courts to sort out conflicting evidence regarding patent claims.

The "predictability" argument thus rests on the utterly unrealistic premise that the Federal Circuit has both the ability to engage in a *de novo* review of the record in every patent case and the expertise to identify the single "correct" meaning of patent claims. Yet patents are drafted for those skilled in the pertinent art, not for judges. As Judge Mayer has observed, "[t]o suggest that appellate judges, precious few of whom are trained in science, will always arrive at the 'true' meaning of words embodying complex concepts endows them with knowledge and enlightenment far beyond those who have training and experience in the field. They are in no position to declare the state of knowledge in the art or that scientific hypotheses are correct as a matter of law." *Pall Corp.*, 1995 U.S. App. LEXIS 27366 at *39 (opinion concurring in judgment). In the *Pall* case itself, the Federal Circuit chose between two competing constructions of a patent, each of which was supported by expert testimony. After reviewing the record, Judge Mayer concluded that "there is little for the uninitiated to choose between the contending interpretations. As far as I can see, this court's action is based on mere preference, thus illustrating the artificiality of *Markman*." *Id.* at *37-38.

The Federal Circuit has launched a constitutional experiment that is as unwise as it is illegitimate. This Court should bring that experiment to a decisive end.

CONCLUSION

For the foregoing reasons, the judgment of the Court of Appeals should be vacated and the case remanded.

Respectfully submitted.

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